


PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. : 10/763,023  
Applicant : Hector F. DeLuca et al  
  
Filed : January 22, 2004  
Title : (20S)-1 $\alpha$ -Hydroxy-2 $\alpha$ -Methyl and 2 $\beta$ -Methyl-19-Nor-Vitamin D<sub>3</sub> and Their Uses  
  
TC/A.U. : 1616  
Examiner : Qazi, Sabiha Naim  
  
Docket No. : 1256-00938

) CERTIFICATE OF MAILING  
) I hereby certify that this correspondence  
) is being deposited with the United States  
) Postal Service with sufficient postage as  
) first class mail in an envelope addressed  
) to: Commissioner of Patents, P.O. Box  
) 1450, Alexandria, VA 22313-1450, on  
) this 26th day of April, 2005.  
)

)   
) April 26, 2005  
) Dorothy A. Hauser Date

TERMINAL DISCLAIMER TO OBVIATE  
A DOUBLE PATENTING REJECTION (37 CFR 1.321(c))

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Identification of Person Making This Disclaimer

I, Thomas M. Wozny, represent that I am an attorney of record authorized to sign on behalf of the assignee identified below.

Identity of Assignee

The assignee is Wisconsin Alumni Research Foundation, a not-for-profit corporation whose address is 614 Walnut Street, 13th Floor, Madison, Wisconsin 53705. The assignee owns all of the interest in the invention claimed in the above-identified patent application.

Recordal of Assignment in Patent Office

The assignment was recorded on June 13, 2002, at Reel 12808, Frames 146-150.

Application No. 10/763,023  
Terminal Disclaimer Dated April 26, 2005  
Submitted in Response to Office Action Dated February 28, 2005  
Attorney Docket No. 1256-00938

Establishing Right of Assignee to Take Action

In accordance with 37 CFR 3.73, I hereby certify that I have reviewed the evidentiary documents with respect to the assignee's ownership of the above-identified patent application and that, to the best of my knowledge and belief, title is in the assignee identified above seeking to take this action.

Disclaimer

The owner hereby disclaims the terminal part of the statutory term of any patent granted on the above-identified instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of the patent granted on second Application No. 08/819,694, filed on March 17, 1997, now U.S. Patent 5,945,410, issued August 31, 1999, except as provided below, and the owner agrees that any patent so granted on the above-identified instant application shall be enforceable only for, and during, such period that the legal title to said patent shall be the same as the legal title to any patent granted on the second application is commonly owned. This agreement runs with any patent granted on the above-identified instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any Terminal Disclaimer filed prior to the patent grant, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 35 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued in any matter or is terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Application No. 10/763,023  
Terminal Disclaimer Dated April 26, 2005  
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Fee Status

This terminal disclaimer is being filed by an applicant that is other than a small entity resulting in a fee of \$110.00 being due.

Fee Payment

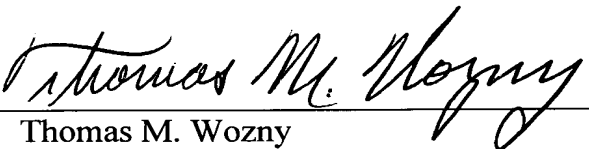
Attached is a check in the sum of \$110.00. The Commissioner is hereby authorized to charge any additional fees in this application under 37 CFR §1.16 and §1.17 to Deposit Account No. 01.2000. An additional copy of this Disclaimer is attached.

Declaration

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statement were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By   
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